

REMARKS

Claims 1-13 and 15-17 are in the case and presented for reconsideration.

Rejections under 35 U.S.C. § 112

Claim 1-13 and 15-17 were rejected under 35 U.S.C. § 112, second paragraph for failing to distinctly claim the subject matter that the applicant regards as the invention. More particularly, the examiner maintains that there is confusion as to the difference in the metal compound, a metal in the zero valent state and the manner of measuring the percentage of metal used in the claimed catalyst. Applicants respectfully traverse this rejection.

Applicants respectfully submit that the claims are clear and distinct as written. Applicants submit that one skilled in the art would fully understand platinum and tin associated with the solid support material present in a “valency greater than zero” would mean not in the elemental metal state. The examiner states that there is confusion due to the use of “valency” when “oxidation state” is more appropriate. However, for the instantly claimed invention, the use of “oxidation state” over “valency” is little more than an exercise in semantics since either term would convey to one skilled in the art that the metals do not exist on the catalyst in their elemental state. Applicants submit that this is very clear from the description and the fact that the examiner candidly admits understanding that heating of the support in the absence of a reducing agent would not result in the metals being reduced to their elemental state.

Accordingly, one skilled in the art would understand that the metals platinum and tin having a “valency greater than zero” as describing a metal not in the elemental metal state. Thus, the use of “oxidation state” over “valency” is irrelevant.

Regarding the weight percentages of metals on the catalyst support, one skilled in the art understands that the exact specie of metal containing compound associated with the support can vary. Therefore, to accurately delineate the amount of active metal it is necessary to state the percentages measured as metal. Applicants submit that the claims as written particularly point out and distinctly claim the subject matter of the instant invention as one skilled in the art would fully comprehend and understand as the examiner himself correctly noted and candidly recognized this fact in the office action. It is not necessary for the description and claims to be of such simplicity that a lay person would understand the scope of the invention. Instead, the accepted measure is that one skilled in the art would be able to understand the invention.

Applicants submit that one skilled in the art having a general understanding of chemistry and catalyst preparation would fully understand the scope of the present invention as it is written with regard to the weight % metals on the catalyst. Evidence that such terms are accepted and understood by one skilled in the art can be seen in US Pat. No. 6,613,938 B2.

Accordingly, Applicants submit that claims 1-13 and 15-17 particularly point out and distinctly claim the subject matter of the instant invention and respectfully request the examiner to withdraw the 35 U.S.C. § 112, second paragraph rejection.

Rejections under 35 U.S.C. § 102

Claims 1 and 4-10 were rejected under 35 U.S.C. § 102 (a) as being anticipated by Zoeller et al., (U.S. 6,235,673). Applicants respectfully traverse this rejection.

Applicants submit that the examiner has not established a *prime facie* 35 U.S.C. § 102 (a) case. Accordingly, the rejection under 35 U.S.C. § 102 (a) is inappropriate.

35 U.S.C. § 102(a) states

"A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent." (emphasis added).

The examiner maintains that the 102(a) reference can only be overcome by a properly executed Rule 131 declaration. Applicants are not disputing this assertion, but rather U.S. Patent No. 6,235,673 is not a proper 102(a) reference. The inventors in the cited reference and the present application are exactly the same, and the '673 patent issued less than 1 year from the filing date of the present application.

Applicants direct the examiner attention to the statutory requirement that "the invention was known or used by others". As has been held in numerous cases, Applicants own disclosure is not properly citeable as prior art under 35 U.S.C. §§102(a) or (e). Applicants respectfully direct the examiner's attention to section 2132 et seq. of the MPEP where it states that "[t]he term "others" in 35 U.S.C. 102(a) refers to any entity which is different from the inventive

entity," and "Applicant's disclosure of his or her own work within the year before the application filing date cannot be used against him or her under 35 U.S.C. 102(a)."

Accordingly, Applicants respectfully submit that claims 1 and 4-10 are not anticipated by U.S. 6,235,673 under 35 U.S.C. § 102 (a) and request the rejection be withdrawn.

Rejections under 35 U.S.C. § 103

Claims 1-13 and 15-17 were rejected under 35 U.S.C. § 103 (a) as being obvious over Zoeller et al. (U.S. 6,235,673, hereinafter '673) in view of Zoeller et al. (U.S. 6,160,163, hereinafter '163). Applicants respectfully traverse this rejection.

Applicants submit that neither the '673 nor the '163 references are in the prior art for the purposes of 35 U.S.C. § 103(a). In establishing obviousness under *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), the scope and content of the prior art must be determined. Thus, the first inquiry is - what is the prior art? *Panduit Corp v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593, 1597 (Fed. Cir), *cert. denied*, 481 U.S. 1052 (1987). Subject matter that is prior art under 35 U.S.C. § 102 can be used to support a rejection under section 103.

However, neither the '673 or the '163 patents are prior art under any section of 35 U.S.C. § 102.

The present application has a filing date of June 19, 2001. The '673 patent has an issue date, i.e. publication date, of May 22, 2001, which is less than 1 year before the application filling date. The '163 patent has a publication date of December 12, 2000 which is also less than 1 year before the application filling date. Moreover, the inventors of the '673 patent and the '163 patent as well as the present application are exactly the same. Accordingly, these two patents are not prior art under 35 U.S.C. § 102. By the examiner maintaining that these two patents are prior art, and not properly accounting for the matter of same inventorship, completely eviscerates the clear meaning of the statute and is contrary to the established case law that holds that the applicant's own work may not be used against him or her unless there is a time bar under 35 U.S.C. § 102(b), *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982).

Accordingly, Applicant respectfully requests that the 35 U.S.C. § 103(a) rejection be withdrawn.

In view of the above, Applicants submit that claims 1-13 and 15-17 are in condition for allowance and respectfully request the examiner pass the application to allowance at the earliest convenience.

Respectfully submitted,

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